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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/619,424 - 07/19/00 KIM K DESS114787

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EXAMINER

ART UNIT

PAPER NUMBER

3724  
DATE MAILED:

7  
10/02/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/619,424

Applicant(s)

Kim et al.

Examiner

Clark F. Dexter

Art Unit

3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-32 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

Art Unit: 3724

## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, drawn to a method of cutting with specific scanning, classified in class 83, subclass 72.
  - II. Claims 1, 7 and 30, drawn to a method of cutting with conveying, classified in class 83, subclass 23.
  - III. Claims 1, 8 and 9, drawn to a method of cutting with specific cutting, classified in class 83, subclass 39.
  - IV. Claims 1 and 10-14, drawn to a method of cutting with specific computing, classified in class 83, subclass 13.
  - V. Claims 15-22 and 32, drawn to a cutting apparatus with a specific workpiece handling structure, classified in class 83, subclass 155.
  - VI. Claims 15 and 23-29, drawn to a cutting apparatus/system with a specific cutter configuration/arrangement, classified in class 83, subclass 404.
  - VII. Claim 31, drawn to a foodstuff product, classified in class 426.
2. Claims 1-14 have been restricted such that the patentability of the invention is presumed to lie in the details of the particular group (e.g. the specific type scanning of Group I). It is noted that if claim 1 as originally filed is part of an elected group and determined to be patentable,

Art Unit: 3724

rejoinder of claims 1-14 will be considered. It is further noted that claim 1 is listed as part of groups I-IV but is not considered to be part any of these groups. Rather, claim 1 recites subject matter that is common to all of the groups and has been shown as part of each group for clarity (i.e., so that it is clear which claims are part of which group). Further, because claim 1 includes subject matter that is common to all of the groups, it is not considered to be independent or distinct from any of the groups. Therefore, claim 1 will be examined upon election of one of the groups. The same applies to claim 15 with respect to the claims dependent therefrom.

3. The inventions are distinct, each from the other because of the following reasons:

Method Groups (I-IV) vs Apparatus Groups (V-VI)

4. Inventions I-IV are related to inventions V-VI as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another materially different apparatus or by hand.

Method Groups (I-IV) vs Product Group (VII)

5. Inventions I-IV are related to invention VII as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as

Art Unit: 3724

claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process; for example, by hand.

Apparatus Groups (V-VI) vs Product Group (VII)

6. Inventions V-VI are related to invention VII as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case, the product as claimed can be made by another and materially different apparatus or by hand.

Method Groups (I-IV)

*Group I vs Groups II-IV:*

7. Inventions of groups I and II are separate inventions. They are distinct because the invention of group I does not require the specific details of the conveying of group II for patentability as evidenced by the omission thereof from group I, and the invention of group II does not require the specific details of the scanning of group I for patentability as evidenced by the omission thereof from group II.

Art Unit: 3724

8. Inventions of groups I and III are separate inventions. They are distinct because the invention of group I does not require the specific details of the cutting of group III for patentability as evidenced by the omission thereof from group I, and the invention of group III does not require the specific details of the scanning of group I for patentability as evidenced by the omission thereof from group III.

9. Inventions of groups I and IV are separate inventions. They are distinct because the invention of group I does not require the specific details of the computing of group IV for patentability as evidenced by the omission thereof from group I, and the invention of group IV does not require the specific details of the scanning of group I for patentability as evidenced by the omission thereof from group IV.

*Group II vs Groups III-IV:*

10. Inventions of groups II and III are separate inventions. They are distinct because the invention of group II does not require the specific details of the cutting of group III for patentability as evidenced by the omission thereof from group II, and the invention of group III does not require the specific details of the conveying of group II for patentability as evidenced by the omission thereof from group III.

11. Inventions of groups II and IV are separate inventions. They are distinct because the invention of group II does not require the specific details of the computing of group IV for patentability as evidenced by the omission thereof from group II, and the invention of group IV

Art Unit: 3724

does not require the specific details of the conveying of group II for patentability as evidenced by the omission thereof from group IV.

*Group III vs Group IV:*

12. Inventions of groups III and IV are separate inventions. They are distinct because the invention of group III does not require the specific details of the computing of group IV for patentability as evidenced by the omission thereof from group III, and the invention of group IV does not require the specific details of the cutting of group III for patentability as evidenced by the omission thereof from group IV.

Apparatus Groups V-VI

13. Inventions of groups V and VI are separate inventions. They are distinct because the invention of group V does not require the specific details of the cutting device of group VI for patentability as evidenced by the omission thereof from group V, and the invention of group VI does not require the specific details of the workpiece handling structure of group V for patentability as evidenced by the omission thereof from group VI.

14. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and have acquired a separate

Art Unit: 3724

status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

15. This application contains claims directed to the following patentably distinct species of the claimed invention:

Figures 2-5; and  
Figure 12.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim appears to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the



Art Unit: 3724

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.


16. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

17. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

  
**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

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September 28, 2001